

Amendment Under 37 C.F.R. § 1.116
U.S. Application No. 09/649,097

Attorney Docket No. Q60517
Art Unit 2635

REMARKS

Claims 1-5, 8-14 and 17-19 have been examined. Applicants are canceling claim 2.

Claims 1, 3-5, 8-14 and 17-19 are all the claims pending in the application.

Rejection of Claims 1-3 under 35 U.S.C. § 103(a)

The examiner rejects claims 1-3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *previously cited* U.S. Patent No. 6,140,939 (hereinafter Flick), in view of *newly cited* U.S. Patent No. 6,484,260 B1 (hereinafter Scott). Applicants respectfully traverse this rejection.

As a preliminary matter, the rejection to claim 2 is rendered moot since it has been cancelled.

When applying 35 U.S.C. § 103, the claimed invention must be considered as a whole and the prior art must be considered as a whole. MPEP §2141 (8th Edition revised Feb. 2003)(Basic Considerations Which Apply to Obviousness Rejections). However, contrary to these basic tenets, the grounds of rejection set forth a piecemeal approach in order to support an obviousness rejection by isolating the identifier and the identifier storage means of applicants' vehicle key system and concurrently disregarding the specific teachings of the applied references, as discussed more fully below.

Page 4, first full paragraph of the final Office action states that "Flick does not explicitly disclose that a transmitter including an identifier storage means for storing an identifier specific to said transmitter." However, "Flick discloses that the transmitter transmits a uniquely coded transponder to the vehicle security systems to operate vehicle control system in prior art (column 1 lines 46 to 55; column 2 lines 3 to 13)."

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Contrary to the examiner's interpretation described above, Flick teaches away from the allegedly corresponding transmitter, identifier and identifier storage means. For example, Flick describes that "the security system may have multiple transponders capable of disabling the ignition or fuel cutoff to thereby permit operation of the vehicles." (Col. 1, lines 58-61). "These uniquely coded transponders may be added or deleted from the vehicle controller.

Unfortunately, the owner of the vehicle may not know that a transponder has been added without authorization." (Emphasis added)(Col. 1, lines 61-64).

Further, Flick concludes by stating that "[u]nfortunately, conventional vehicle security systems using remote transmitters, transponders, and even biometric readers are still subject to a security threat based upon unauthorized learning of a uniquely coded transponder, token, or biometric characteristic, for example. Once such a code or identifying characteristic has been learned by a would-be thief without the owner's knowledge, the thief can return to the vehicle and defeat the security system." (Emphasis Added)(Col. 2, lines 5-13).

Accordingly, in view of these disadvantages outlined by the patentee, and as acknowledged by the examiner, the allegedly corresponding vehicle key system of Flick does not disclose a transmitter for transmitting and storing, *inter alia*, a system-specific identifier, as recited in claim 1. (Page 4, lines 4-5 of Office action). Indeed, Flick's approach explicitly teaches away from this.

On the other hand, Scott describes that in "presently available biometric systems, each authorized person registers with the host facility by providing a sample of their biometric trait, for example, having his fingerprint optically scanned into a host system data base." (Col. 1, lines 32-35). "Each host facility must have a biometric sensor, access to the database of registered

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persons' biometric trait registration data, and a processing system capable of quickly searching the database and conducting the comparison to verify a person's identity." (Col. 1, lines 35-40). "However, if the set of authorized persons is large, such a system would require a huge database to store the fingerprint images of all the authorized persons and the identification process would become slower as the set of authorized persons increases." (Emphasis Added)(Col. 1, lines 40-45).

Accordingly, in view of these disadvantages outlined by the patentees, and as acknowledged by the examiner, the allegedly corresponding vehicle key system of Scott does not disclose a transmitter for transmitting and storing, *inter alia*, fingerprint information, as recited in claim 1. (Page 4, lines 8-13 of Office action). Indeed, Scott's approach explicitly teaches away from this. (See also, col. 5, lines 27-32, 63-67; col. 10, lines 35-39).

The examiner also makes reference to U.S. Patent No. 6,078,265 (hereinafter Bonder) stating that Bonder teaches "a transmitter including an identifier storage means for storing an identifier specific to said transmitter in order to verify that the ID code of the transmitter matches the stored ID code of the device." (Page 4, lines 18-20). In response, applicants incorporate by reference herein the arguments as set forth in the Amendment filed April 2, 2003, with respect to the teachings of Bonder. Bonder fails to teach or suggest the above-mentioned limitations of claim 1.

Taking the prior art as a whole, Flick and Scott (and Bonder) fail to teach or suggest all the limitations of the vehicle system of claim 1.

The vehicle system of claim 1 comprises a transmitter that includes, *inter alia*, a fingerprint capturing means, an identifier storage means for storing an identifier specific to said

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transmitter and a transmitting means for transmitting only the fingerprint information, only the system-specific identifier, or both. Flick, Scott and Bonder, individually or in combination, fail to teach or suggest the above limitations, as required in claim 1.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. In this case, even assuming *arguendo*, that Flick's system teaches capturing and transmitting fingerprint information, and Scott teaches storing and transmitting a system-specific identifier, the prior art as a whole does not teach or suggest a transmitter that transmits both the fingerprint information and the system-specific identifier, as recited in claim 1. Rather, assuming *arguendo*, the prior art teaches transmitting either the allegedly corresponding fingerprint information or the allegedly corresponding system-specific identifier.

Since the applied art does not teach this aspect of the vehicle system of claim 1, it could not teach or suggest the remaining limitations of the claim, that is, the claimed receiver, verification means and control means.

For example, the prior art as a whole, fails to teach or suggest an identifier storage unit for storing a system-specific identifier and an identifier verification unit for verifying a received identifier held by an identifier holding unit against the identifier stored in the identifier storage unit. Specifically, an ID code of Scott is not intended for a system-specific ID code, but for a person or a device.

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For at least these reasons, the examiner has failed to establish a *prima facie* case of obviousness because all the claim limitations are not taught or suggested by the prior art. MPEP §2143.03 (8th Edition).

The grounds of rejection also sets forth that "it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to have a transmitter including an identifier stored in a memory of Scott et al. with the biometric characteristics of Flick with the motivation for doing so would have been to increase the security of the portable remote control identification vehicle system." (Page 4, line 20 through page 5, line 2 of the Office action).

"There are three possible sources of motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP §2143.01 (8th Edition); In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). In this case, the examiner's alleged motivation cannot be objectively traced to any of these sources, as emphasized above. Rather, the alleged motivation is contrived in an attempt to reconstruct the vehicle system of claim 1, based on *impermissible* hindsight alone.

One skilled in the art would not have identified the respective aspects of Flick and Scott (and Bonder) and combined them in the manner claimed, as alleged by the examiner, in order to "increase the security of the portable remote control identification vehicle system." The mere, general proposition of increasing the security of a vehicle system, fails to support that a skilled artisan would have combined these references in the manner claimed, as recited in claim 1. Moreover, as emphasized above, the alleged motivation disregards the specific teachings of each

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reference for the sake of reconstructing the vehicle system of claim 1. The applied references explicitly teach away from one another and/or take different approaches to a similar problem.

For at least these reasons, the examiner has failed to establish a *prima facie* case of obviousness because one skilled in the art would not have been motivated, at the time of the invention, to combine or modify Flick and Scott, in the manner suggested by the examiner.

Accordingly, applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Claim 3 is patentable at least by virtue of its dependency on claim 1, as well as reciting its own patentably distinct features.

Rejection of Claims 4, 5, 8-14 and 17-19 under 35 U.S.C. § 103(a)

The examiner rejects claims 4-5, 8-14 and 17-19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Flick, in view of Scott, as applied to claim 1, and further in view of *previously cited (but not applied)* U.S. Patent No. 6,100,811 (hereinafter Hsu). Applicants respectfully traverse this rejection.

Hsu fails to cure the deficiencies of Flick and Scott with respect to claim 1. ←

The examiner alleges that "Hsu et al. disclose that selecting only the fingerprint information, only the identifier or the both of them according to a manipulation performed by a user (column 2 lines 25 to 47; column 7 lines 27 to 48; see Figure 7) in order to control the operational modes of the remote control system." (Page 7, lines 1-4 of the Office action).

Columns 2 and 7 describe and Figure 7 of Hsu illustrates that after enrollment, "[t]he primary user may select a combination mode 108 in the user interface 80 and, after fingerprint verification of the primary user, the controller 70 enters the combination mode." (Col. 7, lines

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37-40). Hsu describes, in this mode, that "the unlocked mode 102 can only be reached by dialing a secret combination at the ignition switch." (Emphasis added)(Col. 7, lines 40-44). Additionally, "[t]he primary user can disable the combination mode 108 and go to the unlocked mode 102, upon fingerprint verification, and can also change the secret combination (not shown in FIG. 7)." (Emphasis added)(Col. 7, lines 44-47).

The secret combination of Hsu fails to teach, suggest or correspond to the claimed identifier specific to the transmitter. Rather, the secret combination of Hsu is nothing more than a "personal password" (i.e., user password) dialed at the ignition switch by the user, which can be changed by a user. (Col. 7, lines 37-60).

Further, as discussed above, Flick teaches away from using codes in a vehicle system, such as that described above in Hsu, because a security threat exists based upon "authorized learning." (Col. 2, lines 5-10 of Flick). Thus, one skilled in the art would not have even considered this aspect of Hsu, as relating in any motivating way, for combination with Flick and Scott.

For at least these reasons, Flick, Scott, and Hsu, individually or in combination, fail to teach or suggest the transmitter of the vehicle system of claim 1. When viewing the prior art as a whole, applicants respectfully disagree that one skilled in the art, at the time of the invention, would have arrived at the present invention.

Claims 4, 5, 8-14 and 17-19 are patentable at least by virtue of their dependency on claim 1. Accordingly, applicants respectfully request the rejection of claims 4, 5, 8-14 and 17-19 under 35 U.S.C. § 103(a) be withdrawn.

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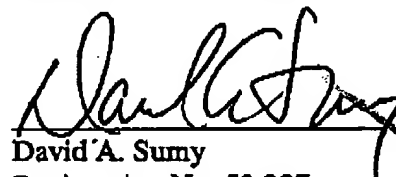
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Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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